UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,861	03/12/2001	Son Phan-Anh	088245-0137	3307

23524   7590   09/23/2008

FOLEY & LARDNER LLP
150 EAST GILMAN STREET
P.O. BOX 1497
MADISON, WI 53701-1497

EXAMINER
LY, NGHI H

ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
09/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>10 June 2008</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,3-5,7,8,10-12 and 14-32</u> is/are pending in the application.
    4a) Of the above claim(s) <u>15-28 and 30</u> is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1,3-5,7,8,10-12,14,29,31 and 32</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) <u>15-28 and 30</u> are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>06/10/2008</u>.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8, 10-12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 8, 10-12 and 14 (filed 08/02/2007), the newly added limitations recite "A computer-readable medium having computer-readable instructions stored thereon that, upon execution by a processor, cause the processor to recover location information, the instructions configured to".

Therefore, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8, 10-12 and 14 are rejected under 35 U. S. C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 8, 10-12 and 14 define a computer-readable medium having computer-readable instructions stored thereon that, upon execution by a processor, cause the processor to recover location information. However, the specification does not define a computer-readable medium and is thus non-statutory for that reason.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

6.   Claims 1, 8, 29, 31 and 32 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bharatia (US 6,763,233) in view of Foti (US 6,839,323) and further in

view of Foti et al (US 6,654,606).

         Regarding claims 1, 8 and 29, Bharatia teaches a method comprising: receiving,

at the Serving-Call State Control Function (S-CSCF) (see column 11, line 40 to column

12, line 3), a registration request from a subscriber in a mobile network (also see

column 11, line 40 to column 12, line 3).

         Bharatia does not specifically disclose the registration request comprises a

Transport Address (TA) of the subscriber.

         Foti (US 6,839,323) teaches the registration request comprises a Transport

Address (TA) of the subscriber (see column 7, lines 15-25 and column 7, line 60 to

column 8, line 2).

         Therefore, it would have been obvious to one ordinary skill in the art at the time

of the invention was made to provide the teaching of Foti (US 6,839,323) into the

system of Bharatia in order to provide a method of monitoring calls in an Internet

Protocol-based network (see Foti, US 6,839,323, column 1, lines 9-11).

         The combination of Bharatia and Foti (US 6,839,323) does not specifically

disclose providing the TA and an address of the S-CSCF to a Home Subscription

Server (HSS) for storage at the HSS, and receiving the TA from the HSS in response to a loss of the TA by the S-CSCF such that the TA in restored at the S-CSCF.

Foti (US 6,654,606) teaches providing the TA (see column 2, lines 9-24) and an address of the S-CSCF (column 2, lines 9-24) to a Home Subscription Server (HSS) for storage at the HSS (see column 2, lines 9-24), and receiving the TA from the HSS in response to a loss of the TA by the S-CSCF such that the TA in restored at the S-CSCF (also see column 2, lines 9-24, where Foti teaches HSS that stores transport address TA and CSCF in case a loss of the TA and CSCF, the TA and CSCF can be received from the HSS).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to provide the teaching of Foti (US 6,654,606) into the system of Bharatia and Foti (US 6,839,323) in order to provide a call processing function that are selectively performed (see Foti, US 6,654,606, column 2, lines 21-22).

Regarding claim 31, the combination of Bharatia, Foti (US 6,839,323) and Foti et al (US 6,654,606) teaches the TA of the subscriber comprises a current Care of Address of the subscriber (see Foti, US 6,654,606, column 2, lines 9-24 and column 3, lines 18-24, where Foti (US 6,654,606) teaches transport address and it reads on applicant's "a Care of Address of the subscriber". In addition, applicant's claim 1, filed 10/19/06, admitted that "the subscriber's Transport Address (TA) which is a current Care of Address of the subscriber").

Regarding claim 32, the combination of Bharatia, Foti (US 6,839,323) and Foti

(US 6,654,606) further teaches the first receiving unit comprises the second receiving

unit (see Bharatia, fig.1A).

7.   Claims 3-5, 7, 10-12 and 14 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bharatia (US 6,763,233) in view of Foti (US 6,839,323) and further in

view of Foti et al (US 6,654,606) and Taguchi et al (US 6,136,532).

Regarding claims 5 and 12, Bharatia teaches a method comprising: receiving, at

a Serving-Call State Control Function (S-CSCF) (see column 11, line 40 to column 12,

line 3), a registration request from a subscriber (also see column 11, line 40 to column

12, line 3).

Bharatia does not specifically disclose the registration request comprises a

Transport Address (TA).

Foti (US 6,839,323) teaches the registration the registration request comprises a

Transport Address (TA) (see column 7, lines 15-25).

Therefore, it would have been obvious to one ordinary skill in the art at the time

of the invention was made to provide the teaching of Foti (US 6,839,323) into the

system of Bharatia in order to provide a method of monitoring calls in an Internet

Protocol-based network (see Foti, US 6,839,323, column 1, lines 9-11).

The combination of Bharatia and Foti (US 6,839,323) does not specifically

disclose the TA comprises a Care of Address of the subscriber, storing the TA in the S-

CSCF, and restoring the TA to the S-CSCF in response to a loss of the TA by the S-CSCF.

Foti (US 6,654,606) teaches the TA comprises a Care of Address of the subscriber (see Foti, US 6,654,606, column 2, lines 9-24 and column 3, lines 18-24, where Foti (US 6,654,606) teaches transport address and it reads on applicant's "a Care of Address of the subscriber". In addition, applicant's claim 1, filed 10/19/06, admitted that "the subscriber's Transport Address (TA) which is a current Care of Address of the subscriber"), storing the TA in the S-CSCF (see column 3, lines 11-34), and restoring the TA to the S-CSCF in response to a loss of the TA by the S-CSCF (see column 3, lines 11-34).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to provide the teaching of Foti (US 6,654,606) into the system of Bharatia and Foti (US 6,839,323) in order to provide a call processing function that are selectively performed (see Foti, US 6,654,606, column 2, lines 21-22).

The combination of Bharatia, Foti (US 6,839,323) and Foti (US 6,654,606) does not specifically disclose storing data in a non-volatile memory.

Taguchi teaches storing data in a non-volatile memory (see column 16, lines 53-58).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to provide the teaching of Taguchi into the system of Bharatia, Foti (US 6,839,323) and Foti et al (US 6,654,606) in order to retain the data in the event of power losses.

Regarding claims 3 and 10, the combination of Bharatia, Foti (US 6,839,323) and Foti et al (US 6,654,606) teaches the TA is stored in the HSS (see Foti, US 6,654,606 column 2, lines 9-24). The combination of Bharatia, Foti (US 6,839,323) and Foti et al (US 6,654,606) does not specifically disclose storing data in a non-volatile memory.

Taguchi teaches storing data in a non-volatile memory (see column 16, lines 53-58).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to provide the teaching of Taguchi into the system of Bharatia, Foti (US 6,839,323) and Foti et al (US 6,654,606) in order to retain the data in the event of power losses.

Regarding claims 4, 7, 11 and 14, the combination of Bharatia, Foti (US 6,839,323) and Foti et al (US 6,654,606) teaches the TA is stored in the HSS (see Foti, US 6,654,606 column 2, lines 9-24). The combination of Bharatia, Foti (US 6,839,323) and Foti et al (US 6,654,606) does not specifically disclose the non-volatile memory comprises a hard disk drive.

Taguchi further teaches the non-volatile memory comprises a hard disk drive (see Taguchi, column 16, lines 53-58).

Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to provide the teaching of Taguchi into the system of Bharatia, Foti (US 6,839,323) and Foti et al (US 6,654,606) in order to retain the data in the event of power losses.

Response to Arguments

8.   Applicant's arguments with respect to claims 1, 3-5, 7, 8, 10-12, 14, 29, 31 and

32 have been considered but are moot in view of the new ground(s) of rejection.

On pages 8 and 10 of applicant's remarks, applicant argues that Foti et al (US

6,654,606) does not teach providing the TA and an address of the S-CSCF to a Home

Subscription Server (HSS) for storage at the HSS, and receiving the TA from the HSS in

response to a loss of the TA by the S-CSCF such that the TA in restored at the S-

CSCF.

In response, Foti (US 6,654,606) does indeed teaches providing the TA (see

column 2, lines 9-24) and an address of the S-CSCF (column 2, lines 14-16, column 3,

lines 31-34, column 4, lines 3-5 and column 4, lines 24-28) to a Home Subscription

Server (HSS) for storage at the HSS (see column 2, lines 9-24), and receiving the TA

from the HSS in response to a loss of the TA by the S-CSCF such that the TA in

restored at the S-CSCF (also **see column 2, lines 9-24, <u>where Foti teaches the HSS

that stores transport address TA and CSCF</u>**, and the TA and CSCF can be received

from the HSS in case a loss of the TA and CSCF. If the TA and CSCF can not be

received from the HSS, as alleged by the applicant, the HSS of Foti does not need to

teach storing the TA and CSCF. A simple example, someone stores music or song on

a CD, tape, floppy disk, so that the music or song can be received later by listening to

the music or song. If the music or song can not be received, someone does not need to

store the music or song).

On pages 11, 12 and 14 of applicant's remarks, applicant argues that Foti II fails to teach "providing the TA and an address of the S-CSCF to a Home Subscription Server (HSS) for storage at the HSS" and "receiving the TA from the HSS" as recited in Claim 1, and similarly recited in Claims 8 and 29.

In response, Foti (US 6,654,606) does indeed teaches providing the TA (see column 2, lines 9-24, **where Foti teaches the HSS that stores transport address TA and CSCF**. In order for the HSS of Foti to store TA and CSCF, the TA and CSCF must be provided to the HSS) and an address of the S-CSCF (column 2, lines 14-16, column 3, lines 31-34, column 4, lines 3-5 and column 4, lines 24-28) to a Home Subscription Server (HSS) for storage at the HSS (see column 2, lines 9-24), and receiving the TA from the HSS (also see column 2, lines 9-24, **where Foti teaches the HSS that stores transport address TA and CSCF**, and the TA and CSCF can be received from the HSS in case a loss of the TA and CSCF. If the TA and CSCF can not be received from the HSS, as alleged by the applicant, the HSS of Foti does not need to teach storing the TA and CSCF. A simple example, someone stores music or song on a CD, tape, floppy disk, so that the music or song can be received later by listening to the music or song. If the music or song can not be received, someone does not need to store the music or song).

On page 14 of applicant's remarks, applicant argues that Foti II fails to teach "storing the TA in a non-volatile memory of the S-CSCF" and "restoring the TA to the S-CSCF from the non-volatile memory in response to a loss of the TA by the S-CSCF" as recited in Claim 5, and similarly recited in Claim 12.

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See In re Keller, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). In this case, Foti et al (US 6,654,606) (**column 2, lines 9-24,** where Foti

teaches restoring the TA to the S-CSCF from the memory in response to a loss of the

TA by the S-CSCF, and see Taguchi, where Taguchi teaches storing data in a non-

volatile memory (see column 16, lines 53-58), and the combination of Bharatia, Foti (US

6,839,323), Foti et al (US 6,654,606) and Taguchi indeed teaches storing the TA in a

non-volatile memory of the S-CSCF" and "restoring the TA to the S-CSCF from the non-

volatile memory in response to a loss of the TA by the S-CSCF" as recited in claims 5

and 1. In addition, applicant's attention is directed to the teaching of Bharatia, Foti (US

6,839,323), Foti et al (US 6,654,606) and Taguchi in claims 5 and 12 above.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to NGHI H. LY whose telephone number is (571)272-7911.

The examiner can normally be reached on 9:30am-8:00pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dwayne Bost can be reached on (571) 272-7023. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly

/Nghi H. Ly/

Primary Examiner, Art Unit 2617